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APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR Michael A. Innis	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,273		08/15/2000		991.001	
27476	7590	10/21/2002			
Chiron Cor			EXAMINER		
Intellectual I P.O. Box 80		R440	LAZAR WESLEY, ELIANE M		
Emeryville, CA 94662-8097				ART UNIT	PAPER NUMBER
				1646	19/
				DATE MAILED: 10/21/2002	<i>k21</i>

Please find below and/or attached an Office communication concerning this application or proceeding.





Office Action Summary

Application No. **09/639,273**

Applicant(s)

Innis

Examiner

Eliane Lazar-Wesley

Art Unit 1646

1) Responsive to communication(s) filed on Jul 29, 2002 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final. 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. Disposition of Claims 4) ☒ Claim(s) 7	The MAILING DATE of this communication appears on the cover sheet with the correspondence address							
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Application/Control Number: 09/639,273

Art Unit: 1646

DETAILED ACTION

1. The amendment filed July 29, 2002 has been entered.

The executed declaration filed July 31, 2002, has been considered.

Claim 7 (amended) is pending and under consideration.

New rejections apply.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is to an isolated and purified biologically active TFP1. The claim is in product-format. However, the claim is confusing, as it recites "...TFP1... according to a method comprising...". It seems that Applicants intend to claim TFP1 made according to a method comprising ..., and that a word or link is missing between the words "TFP1" and "according".

Furthermore, the claim is confusing and/or incomplete, as the preamble is to isolated and purified TFP1, while the method steps lead to the production of an ubiquitin-TFP1 fusion protein. It is not clear if Applicants intended to claim the fusion protein as being the biologically active TFP1, or if they have omitted the cleavage of ubiquitin from the TFP1.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or

on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Wun et al., Thrombosis

and Haemostasis 68: 54-59, 1992, or Nordfang et al., Biochemistry 30: 10371-6, 1991.

The claim is to TFP1, and is in product-format. The claim is in product-format, and as such,

it is the novelty and patentability of the instantly claimed product that need to be established and not

that of the recited process steps. In re Brown, 173 USPQ 685 (CCPA 1972); In re Wertheim, USPQ

(CCPA 1976).

Wun teaches, at page 56, col.2, that the activity of TFP1 expressed and purified from C127

cells, BHK cells and CHO cells have similar factor Xa inhibitory activity.

Nordfang teaches, at page 10371, col.2, that TFP1 expressed in and purified from C127 has

similar anticoagulant activity to TFP1 expressed in and purified from BHK cells.

Applicants, in their declaration, at page 2, § 12, disclose that the activity of TFP1 expressed

in and purified from Saccharomyces cerevisiae as described in the specification, is similar to the

activity of TFP1 expressed and purified from BHK cells, is also similar to the activity of TFP1

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expressed and purified from *E. Coli*, ans is also similar to the activity of TFP1 expressed and purified from C127 cells.

It appears therefore, absence evidence of the contrary, that the instantly claimed TFP1 is identical to the TFP1 described in Wun or Nordfang, and the claim is anticipated.

- 5. No claim is allowed.
- 6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliane Lazar-Wesley, PhD, whose telephone number is (703) 305 4059. The examiner can normally be reached on Monday-Friday from 9:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308 4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

ELW

October 17, 2002

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XVONNE EYLER, PH.D SUPERVISORY PATENT EXAMINER TECHNOLOGY CENTER 1600